

#12 10/10/00 T.Brady

ATTORNEY'S DOCKET NO: S1237/7011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kenneth Walsh
Serial No: 09/408,905
Filed: September 29, 1999
For: AKT Compositions for Enhancing Survival of Cells
Examiner: Nickol, G.
Art Unit: 1642

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, Washington, D.C. 20231, on the 2nd day of October, 2000.

Elizabeth R. Plumer, Reg. No. 36,637

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO SECOND RESTRICTION REQUIREMENT

Sir:

This is in response to the restriction requirement (paper 11) mailed from the United States Patent and Trademark Office on August 30, 2000.

Applicants elect, with traverse, the invention of Group I (claims 1-5), drawn to a method of treating myocardial infarction by administering an Akt molecule, classified in class 514, subclass 2.

Applicants traverse the restriction on the basis that Group II and Group III fall within the invention of Group I. The basis for the traversal is set forth below.

Group I is directed to a method of treating myocardial infarction by administering an Akt molecule. The invention is classified in class 514, subclass 2. Groups II and III are directed to the identical invention as Group I but include the further limitation that the Akt molecule is coadministered with an "anti-atherosclerotic agent" (Group II) or a "growth factor" (Group III). According to the Examiner, Groups I, II, and III are classified in the identical classes.

The Examiner states that the basis for the restriction of Groups I, II, and III is two-fold:

- “Inventions I-IX, and XII-XIII are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success”.
- “... the search required for one group is not required for another group”

Applicants traverse this restriction at least because the search required for Groups II and III is the same search as that required for Group I. To assess the patentability of the invention of Group I, the Examiner will search class 514, subclass 2 to identify prior art relevant to the patentability of a method for treating myocardial infarction. The Examiner admittedly must search this same class and subclass to identify art relevant to the patentability of a method of treating myocardial infarction which further involves co-administering a second agent *in addition to the Akt molecule*. The claims of Groups II and III include the same limitation of the base claim 1, namely administering an Akt molecule to treat myocardial infarction. The inclusion of *additional elements* in the claims of Groups II and III does not affect the nature of the search that must be conducted. If the invention of Group I is patentable, there is no reasonable basis to conclude that prior art uncovered in a different search directed solely to the inventions of Groups II and III would render the inventions of Groups II and III unpatentable.

Applicants further traverse this restriction because the invention of Groups II and III are not “materially distinct methods”. The inventions of Groups II and III are embodiments of the invention of Group I. The specification description of method steps, dosages, schedules, response variables, criteria for success apply equally to Groups I, II, and III.

In view of the foregoing, applicants respectfully request that the Examiner reconsider the restriction and consolidate Groups I, II, and III into a single Group. In the event that the Examiner regroups the claims as requested, applicants elect the species HMG-CoA reductase inhibitors for prosecution on the merits of Group II (claim 7) to which the claims shall be restricted if no generic claim is finally held to be allowable. Upon the allowance of a generic claim, applicant will be

Serial No. 09/408,905

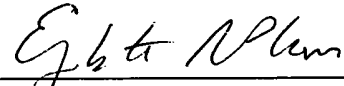
-3-

Art Unit: 1614

entitled to consideration of claims to additional species which are written in dependent form or otherwise to include all the limitations of an allowed generic claims.

Respectfully submitted,

WOLF, GREENFIELD & SACKS, P.C.

By 
Elizabeth R. Plumer, Reg. No. 36,637
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
Attorneys for Applicant(s)
Tel. no. (617) 720-3500

ATTORNEY'S DOCKET NO.: S1237/7011
DATE: October 2, 2000
X09/30/2000



1642

ATTORNEY'S DOCKET NO: S1237/7011

RECEIVED

OCT 11 2000

TECH CENTER 1600/2900

Applicant: Kenneth Walsh
Serial No: 09/408,905
Filed: September 29, 1999
For: AKT Compositions for Enhancing Survival of Cells
Examiner: Nickol, G.
Art Unit: 1642

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, Washington, D.C. 20231, on the 2nd day of October, 2000.

Elizabeth R. Plumer, Reg. No. 36,637

Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL

Sir:

Transmitted herewith are the following:

- ☒ Response to Second Restriction Requirement
- ☒ Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617)720-3500, Boston, Massachusetts.

No check is enclosed as no fee is believed to be due. If this is incorrect, please charge any deficiency to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,

WOLF, GREENFIELD & SACKS, P.C.

By
Elizabeth R. Plumer, Reg. No. 36,637
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
Attorneys for Applicant(s)
Tel. no. (617) 720-3500

ATTORNEY'S DOCKET NO.: S1237/7011

DATE: October 2, 2000

X09/30/2000

483778_1